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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,524	02/12/2004	Masaya Tsunoda	2927-0168P	4127

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,524

Applicant(s)

TSUNODA, MASAYA

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 01/09/2006 – Election.

Applicant's election with traverse of Group II, claims 5-8 in the reply filed on 01/09/2006 is acknowledged. However, in view of an inadvertent error contained within the last restriction requirement, applicant is respectfully asked to consider the following new restriction requirement, set forth herein below. Any inconvenience to the applicant is sincerely regretted.

Moreover, a formal response to applicant's traversal will not be presented at this time, pending applicant's subsequent election and response. Should applicant submit another election with traverse, a complete response to the traversal will be provided along with the first action on the merits.

After further review, it would appear that the inadvertent error in the last restriction requirement mentioned above was due in part to a misinterpretation of the original claim language. More specifically, original claims 6 and 7 each read, "The golf club head according to claim 4". However, claim 4 is drawn to a method of designing a golf club head, not simply a golf club head. It is clear that claim 4 is drawn to a method claim. As written, claims 6 and 7 are drawn to a product claim, but dependent on a method claim. As written, it is not clear if claims 6 and 7 are to be interpreted as a product claim or a method claim. It is further not clear if perhaps the applicant intended claims 6 and 7 to instead depend from claim 5. It is also not clear if perhaps the

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applicant intended claims 6 and 7 to be drafted as a method claims, actually dependent from claim 4.

Applicant is respectfully requested to clarify the status of claims 6 and 7 and make any appropriate amendments to clarify their dependency or form. Note, the following restriction requirement does not place either claim 6 or claim 7 within a specific grouping. Depending upon how applicant clarifies the claim language will determine which grouping claims 6 and 7 will ultimately belong to. If, for example, claims 6 and 7 are amended to properly reflect that they are claims drawn to or dependent from the method (i.e. a method of designing a golf club head), then they will be examined along with an election of the Group I method claims set forth below. If on the other hand, claims 6 and 7 are amended to properly reflect that they are drawn to or dependent from the product (i.e., a golf club head), then these claims will be examined along with an election of the Group II product claims set forth below. Applicant is cautioned to not introduce any new matter in the event that applicant opts to amend the claims.

It is felt that clarification of the dependency and form of claims 6 and 7 along with an updated election of claims for examination by the applicant will result in a more complete and accurate action on the merits.

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Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a method of designing a golf club head, classified in class 473, subclass 409.
- II. Claims 5 and 8, drawn to a golf club head, classified in class 473, subclass 324.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed may be made by another and materially different process such as altering the specifications of the golf club head to arrive at a club head whose thickness and elasticity meet the claimed requirements based upon any one of the following measurable parameters: the distance traveled by a struck ball; the discernable audible feedback generated by the striking of a golf ball against a metal plate; the "feel" that is provided by face plates of diverse material elasticity and thickness. The method of claims 1-4 presents a trial and error style of constructing a preferred golf club head arrangement. Similarly, there are several other trial and error approaches that may be utilized to arrive at the claimed golf club head product.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
March 20, 2006


Sebastiano Passaniti
Primary Examiner